

REMARKS

Applicant respectfully requests reconsideration of this application in view of the following remarks. Claims 1, 6, 11, 19, 20, 24, 25, 29 and 30 have been amended. Claims 1, 2, 4-7, 9-12, and 14-30 are pending.

Rejection of the claims

In the Office Action, independent claims 1, 6 and 11 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2004/0162842 (“Ono”), and independent claims 19, 20, 24, 25, 29 and 30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ono.

Claim 1 recites:

1. A method performed by a computer system, comprising:
 - storing a version of a paper, the version being displayable on a display device as a likeness of the paper;
 - at a first location within the version, detecting a reference to a second location, wherein the detected reference is at least one of the following, other than a computer network address: an alphanumeric character; a symbol; a term; and a phrase;
 - in response to the detected reference, embedding a hyperlink within the detected reference at the first location; and
 - while the first location is displayed on the display device, highlighting the first location to indicate the hyperlink as being selectable at the first location by a user to cause an operation associated with the second location.

Claim 6 recites:

6. A system, comprising:
 - a computing device for:
 - storing a version of a paper, the version being displayable on a display device as a likeness of the paper;
 - at a first location within the version, detecting a reference to a second location, wherein the detected reference is at least one of the following, other than a computer network address: an alphanumeric character; a symbol; a term; and a phrase;
 - in response to the detected reference, embedding a hyperlink within the detected reference at the first location; and
 - while the first location is displayed on the display device, highlighting the first location to indicate the hyperlink as being selectable at the first location by a user to cause an operation associated with the second location.

Claim 11 recites:

11. A computer program product, comprising:
a computer program processable by a computer system for causing the computer system to:
store a version of a paper, the version being displayable on a display device as a
likeness of the paper;
at a first location within the version, detect a reference to a second location,
wherein the detected reference is at least one of the following, other than a
computer network address: an alphanumeric character; a symbol; a term;
and a phrase;
in response to the detected reference, embed a hyperlink within the detected
reference at the first location; and
while the first location is displayed on the display device, highlight the first
location to indicate the hyperlink as being selectable at the first location by
a user to cause an operation associated with the second location; and
apparatus from which the computer program is accessible by the computer system.

Claim 19 recites:

19. A method performed by a computer system, comprising:
storing a version of a paper, the version being displayable on a display device as a
likeness of the paper;
at a first location within the version, detecting a reference to a second location,
wherein the detected reference is at least one of the following, other than a computer
network address: an alphanumeric character; a symbol; a term; and a phrase;
in response to the detected reference, embedding a hyperlink within the detected
reference at the first location, wherein the second location is a file external to the paper,
and wherein the file includes audio signal information; and
while the first location is displayed on the display device, highlighting the first
location to indicate the hyperlink as being selectable at the first location by a user to cause
an operation associated with the second location, wherein the operation includes outputting
audio signals in response to the audio signal information and a selection of the first
location by the user.

Claim 20 recites:

20. A method performed by a computer system, comprising:
storing a version of a paper, the version being displayable on a display device as a likeness of the paper;
at a first location within the version, detecting a reference to a second location, wherein the detected reference is at least one of the following, other than a computer network address: an alphanumeric character; a symbol; a term; and a phrase;
in response to the detected reference, embedding a hyperlink within the detected reference at the first location, wherein the second location is a script; and
while the first location is displayed on the display device, highlighting the first location to indicate the hyperlink as being selectable at the first location by a user to cause an operation associated with the second location, wherein the operation includes executing the script in response to a selection of the first location by the user.

Claim 24 recites:

24. A system, comprising:
a computing device for:
storing a version of a paper, the version being displayable on a display device as a likeness of the paper;
at a first location within the version, detecting a reference to a second location, wherein the detected reference is at least one of the following, other than a computer network address: an alphanumeric character; a symbol; a term; and a phrase;
in response to the detected reference, embedding a hyperlink within the detected reference at the first location, wherein the second location is a file external to the paper, and wherein the file includes audio signal information; and
while the first location is displayed on the display device, highlighting the first location to indicate the hyperlink as being selectable at the first location by a user to cause an operation associated with the second location, wherein the operation includes outputting audio signals in response to the audio signal information and a selection of the first location by the user.

Claim 25 recites:

25. A system, comprising:
a computing device for:
storing a version of a paper, the version being displayable on a display device as a likeness of the paper;
at a first location within the version, detecting a reference to a second location, wherein the detected reference is at least one of the following, other than a computer network address: an alphanumeric character; a symbol; a term; and a phrase;
in response to the detected reference, embedding a hyperlink within the detected reference at the first location, wherein the second location is a script; and
while the first location is displayed on the display device, highlighting the first location to indicate the hyperlink as being selectable at the first location by a user to cause an operation associated with the second location, wherein the operation includes executing the script in response to a selection of the first location by the user.

Claim 29 recites:

29. A computer program product, comprising:
a computer program processable by a computer system for causing the computer system to:
store a version of a paper, the version being displayable on a display device as a likeness of the paper;
at a first location within the version, detect a reference to a second location, wherein the detected reference is at least one of the following, other than a computer network address: an alphanumeric character; a symbol; a term; and a phrase;
in response to the detected reference, embed a hyperlink within the detected reference at the first location, wherein the second location is a file external to the paper, and wherein the file includes audio signal information; and
while the first location is displayed on the display device, highlight the first location to indicate the hyperlink as being selectable at the first location by a user to cause an operation associated with the second location, wherein the operation includes outputting audio signals in response to the audio signal information and a selection of the first location by the user; and
apparatus from which the computer program is accessible by the computer system.

Claim 30 recites:

30. A computer program product, comprising:
a computer program processable by a computer system for causing the computer system to:
store a version of a paper, the version being displayable on a display device as a
likeness of the paper;
at a first location within the version, detect a reference to a second location,
wherein the detected reference is at least one of the following, other than a
computer network address: an alphanumeric character; a symbol; a term;
and a phrase;
in response to the detected reference, embed a hyperlink within the detected
reference at the first location, wherein the second location is a script; and
while the first location is displayed on the display device, highlight the first
location to indicate the hyperlink as being selectable at the first location by
a user to cause an operation associated with the second location, wherein
the operation includes executing the script in response to a selection of the
first location by the user; and
apparatus from which the computer program is accessible by the computer system.

In MPEP § 2131, the PTO provides that:

*“[t]o anticipate a claim, the reference must teach every element of
the claim....”*

Therefore, to sustain a rejection of claim 1, Ono must contain all of the above-recited elements in claim 1. However, Ono fails to teach the combination of elements in claim 1. In fact, Ono teaches away from such a combination.

For example, Ono detects a keyword in a **KWIC** document, but Ono embeds a clickable link within an **abstract** document (whose likeness is different from the KWIC document's likeness). In Ono, FIG. 12 shows an example of the abstract document, and FIG. 14 shows an example of the KWIC document. In the last sentence of paragraph [0111], Ono states, “What is presented when the user reads the abstract document and refers to the original page via the link embedded within the abstract document is the KWIC document.” In paragraph [0156], Ono states, “‘Internet’ and ‘Intranet’ indicated by bold letters in the display in FIG. 12 are clickable and links **to** corresponding portion of the KWIC document are embedded therein” (emphasis added). Accordingly, in the last sentence of paragraph [0156], Ono states, “That is, the display is changed as shown in FIG. 14.”

By comparison, claim 1 requires: *at a first location* within the version, detecting a reference to a second location; and, in response to the detected reference, *embedding a hyperlink within the detected reference at the first location*; and, while the first location is displayed on the display device, highlighting the first location to indicate the hyperlink as being *selectable at the first location* by a user to cause an operation associated with the second location.

Therefore, by embedding its clickable link within the abstract document (whose likeness is different from the KWIC document's likeness), Ono clearly teaches away from claim 1, because Ono fails to embed its clickable link at the location where Ono detects the keyword in the KWIC document.

Accordingly, Ono fails to support a rejection of claim 1 under 35 U.S.C. § 102(e). In relation to claims 6 and 11, Ono is likewise defective in supporting a rejection under 35 U.S.C. § 102(e).

Moreover, as stated in MPEP § 2142, "...The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness..." Also, MPEP § 2142 states: "...the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made...The examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole.'" Further, MPEP § 2143.01 states: "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination."

In relation to claim 1, Ono is defective in establishing a *prima facie* case of obviousness. As between Ono and Applicant's specification, only Applicant's specification teaches the combination of elements in claim 1. In fact, Ono teaches away from such a combination. Accordingly, the PTO's burden of factually supporting a *prima facie* case of obviousness has not been met.

In relation to claims 6, 11, 19, 20, 24, 25, 29 and 30, Ono is likewise defective in establishing a *prima facie* case of obviousness.

Thus, a rejection of claims 1, 6, 11, 19, 20, 24, 25, 29 and 30 is not supported.

Conclusion

For these reasons, and for other reasons clearly apparent, Applicant respectfully requests allowance of claims 1, 6, 11, 19, 20, 24, 25, 29 and 30.

Dependent claims 2, 4, 5 and 16-18 depend from and further limit claim 1 and therefore are allowable.

Dependent claims 7, 9, 10 and 21-23 depend from and further limit claim 6 and therefore are allowable.

Dependent claims 12, 14, 15 and 26-28 depend from and further limit claim 11 and therefore are allowable.

An early formal notice of allowance of claims 1, 2, 4-7, 9-12, and 14-30 is requested.

To the extent that this Response to Office Action results in additional fees, the Commissioner is authorized to charge deposit account no. 50-3524.

Applicant has made an earnest attempt to place this case in condition for allowance. If any unresolved aspect remains, the Examiner is invited to call Applicant's attorney at the telephone number listed below.

Respectfully submitted,



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